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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/034,415	03/04/1998	PASCAL MICHAUD	1798-7267	3308

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EXAMINER

CROSS, LATOYA I

ART UNIT	PAPER NUMBER
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1743

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DATE MAILED: 05/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-30

Office Action Summary

Application No.

09/034,415

Applicant(s)

MICHAUD, PASCAL

Examiner

LaToya I. Cross

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-8 and 11-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-8 and 11-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 28, 2002 has been entered. Claims 1-4, 6-8 and 11-16 are pending.

Claim Rejections - 35 USC 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6 and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 3,957,672 to Zisman et al (hereinafter Zisman et al '672).

Applicants' claimed invention is directed to a dewetting composition consisting essentially of at least one surfactant in admixture with at least one fluorinated solvent and at least one water immiscible polyfluorinated alcohol having a specified formula.

Zisman et al '672 disclose a surface active composition for displacing aqueous or organic liquid films from solid surfaces. The surface active composition contains a fluorinated polyether which provides the surface activity to the composition. The composition may additionally contain fluoroalcohols and perfluoroalkane solvents. See claim 1 of Zisman et al

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'672. The fluoroalcohols have the formula $F(CF_2)_mCH_2OH$, similar to that instantly claimed by Applicants and encompassing Applicants' preferred alcohol, tridecafluorooctanol. The fluoroalcohols are present in an amount of up to 1% (col. 3, lines 10-34 and col. 7, lines 30-33). The perfluoroalkane solvents may include perfluorohexane and are present in an amount of up to 99% by volume. The amount of fluorinated polyether used is from 0.5 to about 1% by weight (col. 4, lines 60-61).

Zisman et al '672 differ from the instantly claimed invention in that there is no disclosure of the composition not exhibiting a flash point. However, because the composition of Zisman et al '672 comprises similar components as claimed by Applicants, one of ordinary skill in the art would expect that they would have similar properties including flash point, absent evidence to the contrary.

Also Zisman et al '672 do not disclose the boiling point of the fluorinated solvents. However, since the reference discloses perfluoroalkane solvents (i.e. perfluorohexane), which are the same as Applicants' claimed solvents, one would expect that the boiling point would fall within the claimed range.

Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be obvious within the meaning of 35 USC 103 in view of the teachings of Zisman et al '672.

4. Claims 1-3, 7, 8 and 7-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zisman et al '672 in view of US Patent 5,514,301 to Bil et al (hereinafter Bil et al '301).

A different embodiment of Zisman et al '301 consists of the displacement of liquids from solid surfaces for short periods of time. In this embodiment, Zisman et al '672 disclose the use

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of the fluorinated polyether compound as a solvent in combination with the fluoroalcohol (col. 4, lines 56-65).

This embodiment differs from the instantly claimed invention in that no surface active agent is provided.

Bil et al '301 teach compositions for dewetting solid surfaces. The compositions of Bil et al '301 comprise a surface active material prepared by the reaction of alkyl phosphoric acids, fluorinated amine and a quaternary ammonium chloride in solution with a halogenated solvent. Bil et al '301 disclose that in using such surface active agents, the de-emulsification time can be reduced and in the dewetting process, separation of the aqueous phase and organic phase will be accelerated. See col. 1, lines 26-32 and col. 2, lines 1-8.

Thus, it would have been obvious to one of ordinary skill in the art to use the surface active agent described in Bil et al '301 in the dewetting compositions of Zisman et al '672 in order to allow the emulsion formed by the dewetting composition with the extracted water to better separate into two phases allowing the aqueous phase to be removed faster.

Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be obvious within the meaning of 35 USC 103 in view of the teachings of Zisman et al '672 and Bil et al '301.

Response to Arguments

5. Applicant's arguments filed March 28, 2002 have been fully considered but they are not persuasive. Applicants have incorporated specific amounts of compounds into independent claim 1. These amounts are within the teachings of the Zisman reference. Specifically, Zisman teaches up to 1% fluoroalcohol, up to 1% surfactant, and up to 99% perfluoroalkane. These

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amounts encompass the ranges claimed by Applicants. Absent some evidence that Applicants' specific ranges provide unexpected results, the claimed amounts are deemed obvious over Zisman. Applicants further state that new claim 16 is unobvious of Zisman in view of Bil because Zisman requires a fluoropolyether which Applicants' now exclude. Applicants' claims do not exclude fluoropolyethers. Applicants use "consisting essentially of" language with is exclusive only where it is shown that the additional components materially effect the composition. See MPEP 2111.03.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is 703-305-7360. The examiner can normally be reached on Monday-Friday 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 703-308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

LIC
May 1, 2002


Jill Warden
Supervisory Patent Examiner
Technology Center 1700